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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91197504
Party	Defendant Alpha Phi Omega
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

OMEGA, S.A., OPPOSER, v. ALPHA PHI OMEGA, APPLICANT.	Opposition Nos. 91197504 (Parent) & 91197505 (Child) Serial Nos. 77950436 & 77905236

SUPPLEMENTAL BRIEF IN SUPPORT OF
ALPHA PHI OMEGA'S MOTION FOR SUMMARY JUDGMENT

Comes the Applicant, Alpha Phi Omega, by counsel and for its Supplemental Brief In Support of its Motion for Summary Judgement, it submits the following:

The Alpha Phi Omega Marks.

As noted in earlier filings associated with this motion, the Alpha Phi Omega National Service Fraternity was founded in 1925 and at that time the founders adopted the trade name, ALPHA PHI OMEGA, its Greek Alphabet equivalent, ΑΦΩ, and the coat-of-arms shown here as marks of the fraternity. The word mark is registered for "Indicating membership in a service fraternity" based upon a first use as early as 1925 (Reg. No. 3,840,594), for "Association services, namely, promoting the interests of the members of a fraternal service association" based upon a first use date of December 16, 1925 (Reg. No. 2,315,321), and for assorted lines of apparel based upon a first use as early as 1980 (Reg. No. 3,828,181). The Greek alphabet letter equivalent of the word mark, the letter combination, ΑΦΩ, is likewise registered for "Indicating membership in a service fraternity" based upon a first use as early as 1925 (Reg. No. 3,835,075), and the letters were *previously*

registered in 1929 for assorted line of jewelry based upon a first use date of December 16, 1925 (Reg. No. 265,052). Although the fraternity regularly renewed th'052 jewelry registration, it inadvertently neglected to file the renewal due in 1999, although it has continued to use the letters for jewelry. The coat-of-arms shown above is registered for "Indicating membership in a service fraternity" based upon a first use as early as 1925 (Reg. No. 3,835,075) and for "Association services, namely, promoting the interests of the members of a fraternal service association" based upon a first use date of December 16, 1925 (Reg. No. 2,320,138).

One of the pending Oppositions challenges the application to now register this coat-of arms for jewelry relating to first use "as early as 1930," although there is evidence of record that the first use date of this mark with jewelry was actually as early as March, 1929. *See* Def Ex 5 to Reply in Support of Motion for Summary Judgment.

The other pending Opposition challenges the application to now register the Greek Alphabet letters, ΑΦΩ, for assorted lines of apparel based with a first use as early as 1980. As an aside from the question we are directed to brief, the Board should note that Opposer's challenge to this application should be precluded under *Morehouse* because Applicant is the owner of a pre-existing incontestible registration of an equivalent mark, the registration of the phonetically equivalent words, ALPHA PHI OMEGA, for the same goods, namely Registration No. 3,828,181. *See Morehouse Mfg. Corp. v. J. Strickland & Co.,* 407 F.2d 181, 160 USPQ 715, 717 (CCPA 1969) ("if opposer cannot procure the cancellation of the existing registration it cannot prevent the granting of the second registration; that there is no added damage from the second registration of the same mark if the goods named in it are in fact the same; and that if there is no added damage, there is no ground for sustaining the opposition").

The Question

Presumably because the marks which were adopted by Applicant in 1925 were not used on clothing from the outset, the Board has requested supplemental briefing on the following question:

> Whether a plaintiff, in order to prove a dilution claim under the Trademark Act in a Board proceeding where defendant's application/registration is based on use in commerce, must establish that its mark became famous prior to defendant's use of its subject mark in commerce as to any goods or services or whether plaintiff must establish that its mark became famous prior to defendant's use of its subject mark in commerce in connection with the goods and/or services specifically identified in defendant's subject application or registration.

Literal Meaning of Statute

The pertinent part of the statute upon which this question is based literally reads as follows:

> Subject to the principles of equity, the owner of a famous mark . . . shall be entitled to [relief] against another person who, at any time after the owner's mark has become famous, *commences use of a mark* or trade name in commerce that is likely to cause dilution.

15 U.S. C. § 1125(c)(1) (emphasis added). The Dilution Act does not define "mark" any differently than does the Lanham Act itself which defines a "trademark" (and similarly a "service mark") as follows:

> any word, name, symbol, or device [used] to identify and distinguish his or her goods . . . from those manufactured or sold by others and to indicate the source of the goods.

The Lanham Act definitions of trademark and service mark do not narrowly limit the definitions of mark to any specified goods or services; the literal definition relates only to the mark itself. Nor does the Dilution Act further limit the Lanham Act definitions to something such as "who, at any time after the owner's mark has become famous, commences use [in

relation to any specific goods or services] of a mark . . .” (highlighted language added to demonstrate how Congress could have limited the applicability of this defense had it intended to do so).

It is clear Congress knows how to so limit use of the word “mark” in a statute to use in relation to specific goods or services. For example, in relation to counterfeiting portion of the Lanham Act, Congress did expressly note that use of the word “mark” in the context of counterfeiting means use of the “mark” in relation to specific goods and services. 15 U.S.C. § 1116(d)(1)(B) (“As used in this subsection the term ‘counterfeit mark’ means - (i) a counterfeit of a mark that is registered on the principal register in the United States Patent and Trademark Office ***for such goods or services*** sold, offered for sale, or distributed and that is in use”) (emphasis added).

Accordingly, Congress has demonstrated an ability to limit the use of the word “mark” to something narrower than simply the mark itself. Had Congress intended to limit the pertinent use of the word “mark” in the Dilution Act to a different date of first use as to each differing use made of the mark, Congress has demonstrated it knows how to so wordsmith the statute when it intends to do so.

So, to literally interpret the Act in relation to the question presented by the Board, the answer seems to be, the Opposer “must establish that its mark became famous prior to defendant’s use of its subject mark in commerce *as to any goods or services,*” not whether all it has to “establish [was] that its mark became famous prior to defendant’s use of its subject mark in commerce in connection with the goods and/or services specifically identified in defendant’s subject application or registration.”

The Case Law is Uniformly Consistent With the Literal Reading of the Statute

The only case law we could uncover addressing the question of the requisite fame date when the use of the mark by others evolves over time is *Network Network v. CBS, Inc*., 2000 U.S. Dist. LEXIS 4751 (C.D. Cal. Jan. 16, 2000), *Nissan Motor Co. v. Nissan Computer Corp*., 378 F.3d 1002, 1012-1013 (9th Cir. 2004), and *Rosetta Stone Ltd. v. Google, Inc*., 676 F.3d 144, 172 (4th Cir. Va. 2012). These cases uniformly hold that "the defendant's first diluting use of a famous mark 'fixes the time by which famousness is to be measured' for purposes" of addressing fame in the context of dilution. *Rosetta Stone*, 676 F.3d at 172 (quoting *Nissan Motor Co*., 378 F.3d at 1013).

Network Network v. CBS, Inc., 2000 U.S. Dist. LEXIS 4751 (C.D. Cal. Jan. 16, 2000) appears to be the first case to address this question. There, the challenged TNT mark was first used for television programming in 1989 and the mark later, in 1994, evolved to "TNT.COM" for a website. The court found that the statute requires the mark claimed to be famous must be famous by the time of the other user's first commercial use, not when some later evolved use occurs that the dilution claimant finds objectionable. *Network Network*, 2000 U.S. Dist. LEXIS 4751, *10. In short, the first date of use is the one that matters, not some later evolved use.

The Court in *Nissan Motor Co. v. Nissan Computer Corp*., 378 F.3d 1002, 1012-1013 (9th Cir. Cal. 2004) agreed with this assessment. In *Nissan Motor Co.*, the owner of a computer and Internet company began using his surname, Nissan, as the trade name for his business and then years later registered "nissan.com" as a domain name for his website. The Ninth Circuit held that the first commercial use is the relevant first use by which the dilution claimant's mark must be famous. Thus, the Court held that the requisite date of fame should relates to the date "Nissan" was used for computers by Nissan Computer mark, not when nissan.com was registered.

The Fourth Circuit followed the Ninth Circuit's lead in deciding *Rosetta Stone Ltd. v. Google, Inc.*, 676 F.3d 144, 171-173 (4th Cir. 2012). When Rosetta Stone sued Google for diluting its mark by using it as a keyword to trigger advertising, the Fourth Circuit held that the key date for determining whether the ROSETTA STONE trademark was "famous" was in 2004, when Google's diluting use first began. *Id.* The Court noted that the statute does not permit the owner of a famous mark to pick and choose which diluting use counts for purposes of § 1125(c)(1). *Id.* at 172 (citing *Nissan Motor Co*., 378 F.3d at 1013) ("If . . . first use for purposes of § 1125(c) turned on whatever use the mark's owner finds particularly objectionable, owners of famous marks would have the authority to decide when an allegedly diluting use was objectionable, regardless of when the party accused of diluting first began to use the mark.").

The Dilution Act Reference to "Trade Name" also Indicates This is the Appropriate Interpretation

It is important to note that the portion of the Dilution Act in issue actually provides that it is the burden of the dilution claimant to prove fame which predates the commencement of "use of a mark ***or trade name***" allegedly likely to cause dilution.

The Lanham Act definition of "trade name" as the Board is no doubt well aware "means any name used by a person to identify his or her business or vocation." 15 U.S.C. § 1127. Unlike marks which are specifically associated with a product, trade names typically relate to a business in general, not its specific products. Granted a trade name can also actually be used as a trademark, but need not be. Like here, ALPHA PHI OMEGA and the Greek equivalent letters, ΑΦΩ, are not only trademarks, they also serve as collective membership symbols, as well as the ***trade name*** of the fraternity.

Because a dilution claimant must prove the existence of fame before its adversary "commences use of a mark ***or trade name*** in commerce that is likely to cause dilution," it would

be incongruous to find that the challenged mark or name could nonetheless be challenged in association with later use of that same tradename as a mark in relation to any evolving product lines with which the owner is using its name as a mark for its products if the claimant's mark was not famous prior to adoption of the trade name itself.

Such A Rule Seems Especially Appropriate When The Later Goods Are Closely Related To The Other Goods

Considering that it would be incongruous to hold that a dilution claimant's mark must be famous before the adoption of a challenged trade name, but could nonetheless reach other use of that trade name with the owner's later goods, it would seem likewise incongruous to hold that even though the claimant's mark was not famous, and thus not diluted by their adversary's first use as a trademark, it could be diluted by later revised uses for the mark, especially if the later product lines, in the relevant market, are closely related to the initial product lines.

The relevant market for the Applicant's products is the fraternity affinity goods market. As is traditional with collective membership organizations, especially collegiate fraternities and sororities, it is common for student members of the organization to acquire assorted mementos bearing the insignia of the beloved organization by which the member displays his or her membership in and affection for their respective fraternity or sorority.

> Products containing a fraternity or sorority's names or insignia are sold because those buying them wish to identify themselves with that organization. . . . Similar to the emblems or symbols of sports teams, new members' desire to associate with their new fraternity or sorority fuels their desire to purchase items with their sorority's name or insignia on them.

Abraham v. Alpha Chi Omega, 781 F.Supp.2d 396, 416 (N.D.Tx. 2011) *aff'd* 708 F.3d 614 (5th Cir. 2013) *cert. denied*, 134 S.Ct. 88 (2013).

Applicant has used its marks as trade names, as collective membership marks, and as marks for jewelry since 1925. In addition to jewelry, fraternities typically produce or license

others to produce a wide assortment of affinity merchandise bearing a fraternity's name, its Greek letter insignia, and other insignia. Such merchandise includes, but is not limited to, shirts, hats, jackets, sweatshirts, intramural sports uniform shirts, banners, flags, car window decals, watches, clocks, glassware, plaques, stationery, and tote bags. *See* Exhibits to Motion for Summary Judgment, namely, London Depo. pps 34, 36, 123; Plaintiff's Exhibits 12, 13, 17 & 21; Miraglia, Wampler, and Smiley Decls. ¶ 4; Shaver Decl. ¶ 7.

As the PTO readily recognizes, it is not at all uncommon for a membership organization to use its marks as collective membership marks denoting membership, as well as on goods as trademarks. "[N]otwithstanding the use of a collective trademark or collective service mark by the members of the collective, the collective itself may also use the same mark as a trademark for the goods or services covered by the collective trademark or service mark registration." TMEP § 1304.01. Indeed, with affinity merchandise such as jewelry, apparel, banners, decals, and so forth, these are the traditional ways in which members of a collective membership organization such as a fraternity actually use the marks to denote their membership: by displaying the marks on their jewelry and apparel. The PTO even recognize this in the TMEP:

> Many associations, particularly fraternal societies, use jewelry such as pins, rings, or charms to indicate membership. . . .
>
> Shoulder, sleeve, pocket, or similar patches, or lapel pins, whose design constitutes a membership mark and which are authorized by the parent organization for use by members on garments to indicate membership, are normally acceptable as specimens. Clothing authorized by the parent organization to be worn by members may also be an acceptable specimen.

TMEP § 1304.02(a)(i)(C).

This is the Wrong Case to Decide the Question;
Even if the Rule Were Otherwise, it Would Make No Difference
in the Outcome of This Case

As discussed above, the answer to the Board's question seems to be the Opposer "must establish that its mark became famous prior to defendant's use of its subject mark in commerce *as to any goods or services,*" not whether all it has to "establish [was] that its mark became famous prior to defendant's use of its subject mark in commerce in connection with the goods and/or services specifically identified in defendant's subject application or registration."

Even if the rule were otherwise, it would make no difference in this case. Even if Omega only needed to prove fame prior to the 1980 to succeed with a dilution claim relating to the application to register the ΑΦΩ mark for apparel, Omega's did not come forward with any proof to show fame for dilution purposes prior to the 1980s. All Opposer has come forward with to support its burden to prove fame is sales and marketing data and media attention *from this century* The putative "proof" presented by Opposer, sales and marketing data from 2000 to 2009 is completely irrelevant to the question hand.

So whether the key date for which Omega must prove fame for dilution purposes is 1925 when Alpha Phi Omega adopted its tradename and membership marks, by at least 1929 when the ΑΦΩ coat-of-arms was in use for jewelry or before the marks were used on clothing at least as early as 1980 really doesn't matter in this case, because Omega has not shown fame for dilution purposes preceding *any of those dates.*

Indeed, even the Board itself has in essence *recently held more than once* that considering the widespread uses of the word Omega in a multiplicity of unrelated marks used by others, the Opposer's Omega marks are not famous enough to support a dilution claim. *See Omega SA v. Hanif,* 2013 TTAB LEXIS 420, *17-18 (TTAB August 5, 2013). In that proceeding, the Board did recognize there is notoriety associated "with opposer's mark *with*

respect to opposer's timepieces" but most telling, as the Board there noted "*[t]here is no evidence that opposer has established fame with respect to goods other than watches.*" *Id.* at *17 (emphasis added). *See also Omega S.A. v. Alliant Techsystems Inc.,* No. 91173785 *http://ttabvue.uspto.gov/ttabvue/v?pno=91174067&pty=OPP&eno=24* slip op. at 13 (TTAB April 29, 2015) (" Opposer's OMEGA mark is famous, *but only for watches*" (emphasis added)).

Because Opposer bears the burden of proof, it must come forward at the Summary Judgment juncture with a showing its marks became famous for dilution purposes prior to Alpha Phi Omega's commencement of use of its marks. The showing made by Opposer of sales, marketing and publicity from 2000 to 2009 is totally irrelevant to the dilution issue here, even if Opposer only had to show fame prior to 1980 to succeed with a dilution based Opposition to the application to register AΦΩ for apparel.

CONCLUSION

In relation to the question presented by the Board, the answer seems to be the Opposer "must establish that its mark became famous prior to defendant's use of its subject mark in commerce *as to any goods or services,*" not whether all it has to "establish [was] that its mark became famous prior to defendant's use of its subject mark in commerce in connection with the goods and/or services specifically identified in defendant's subject application or registration."

Regardless, under the facts of this proceeding, the determination of the question really makes no difference. The showing made by Opposer of sales, marketing, and publicity from 2000 to 2009 is totally irrelevant to the dilution issue here, even if the key date in relation to the application to register AΦΩ for apparel is 1980, rather than 1925 when ALPHA PHI OMEGA adopted its trade name and marks.

Respectfully requested,

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CERTIFICATE OF SERVICE AND ELECTRONIC SUBMISSION

I hereby certify that a true copy of this SUPPLEMENTAL BRIEF IN SUPPORT OF ALPHA PHI OMEGA'S MOTION FOR SUMMARY JUDGMENT is being filed electronically with the U.S. Patent and Trademark Office using the ESTTA service, and a copy has been served on counsel for Opposer by mailing said copy this 23rd day of October, 2015, via First Class Mail, postage prepaid, to:

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